

REMARKS

As a preliminary matter, Applicants would like to express appreciation for the courtesies extended by Examiner St. Cyr to Applicants' representative during the interview conducted on July 5, 2005 (hereinafter the "Interview"). The substance of the interview is incorporated into the remarks below and constitutes Applicants' record of the interview.

Claims 1, 3, 5, 6, 8-17, 34 and 35 are allowed. By this Response, no claims are amended, added or canceled. Claims 1, 3, 5, 6, 8-17, and 23-37 are pending in the patent application. Reconsideration and allowance of the present patent application based on the following remarks are respectfully requested.

Applicants appreciate the Examiner's indication that claims 1, 3, 5, 6, 8-17, 34 and 35 are allowed.

Claims 23-33 and 37 were rejected under 35 U.S.C. §103(a) based on Aubrey (U.S. Pat. No. 4,798,942) in view of Cubic Transportation System (hereinafter "Cubic"). The rejection is respectfully traversed.

Claim 23 recites an automatic ticket checking apparatus comprising a main body, which defines a first passage to one side thereof and a second passage to another side thereof; first receiving means provided to the main body for receiving using data from a first wireless ticket which is carried by a first user who is passing the first passage in a first direction and recording the using data; first judging means for judging a passing propriety of the first user based on the using data received by the first receiving means; approving means for approving the passing of the first user when the passing is judged to be approved by the first judging means; second receiving means provided to the main body for receiving using data from a second wireless ticket which is carried by a second user passing the second passage in a second direction opposite to the first direction and recording the using data; second judging means for judging a passing property of the second user based on the using data received by the second receiving means; third judging means for judging whether the second wireless ticket is the same as the first wireless ticket that is carried by the first user who was approved to pass by the approving means based on the using data received by the second receiving means; prohibiting means for prohibiting the execution of judging the passing property of the second user by the second judging means when the second wireless ticket is judged to be the same as the first wireless ticket by the third judging means; and control means for executing the judging a passing property of the second user by the second judging means when the

second wireless ticket is judged differing from the first wireless ticket by the third judging means.

As conceded by the Examiner on page 3, lines 3-5, of the Office Action, Aubrey fails to teach or suggest that the ticket processing includes wireless and judging means for processing the wireless tickets. However, the Examiner relies on Cubic as allegedly remedying the deficiencies of Aubrey. Applicants respectfully disagree and submit that the Office Action has failed to establish a *prima facie* case of obviousness for at least the following reasons.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (See MPEP 2143). Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants respectfully submit that these criteria have not been met.

First, Applicants respectfully submit that Cubic cannot be used as a prior art reference in the present rejection because Cubic does not bear a publication date that antedates the U.S. filing date or the priority date of the present application. Applicants respectfully note that the only date set forth by Cubic is February 6, 2003 (see bottom right corner of the document), which is after the U.S. priority date of the present application, *i.e.*, February 28, 2001, or the priority date of the Japanese Patent Application, *i.e.*, February 29, 2000. Although all printed publications may be used as references, Applicants note that the date to be cited must be the publication date. (See MPEP 901.06). Furthermore, the PTO guidelines mandate that an electronic publication, including an on-line database or Internet publication, can be considered a printed publication within the meaning of 35 U.S.C. §102(a) and (b), only if the publication was accessible to persons concerned with the art to which the document relates. (See MPEP 2128 citing *In re Wyer*, 655 F.2d 221, 227, 210 USPQ 790, 795 (CCPA 1981)). Applicants note that the Cubic reference cannot have a publication date prior to February 2001 because Cubic literally indicates on page 2, paragraph 9 that "under a new \$20 million contract, **awarded** by WMATA in February 2001, Cubic will extend..." (Emphasis added to indicate past tense). As a result, Applicants respectfully submit that the Cubic reference was not published before March 2001 and, therefore, was not accessible to persons concerned

with the art to which the document relates prior to February 2001, that is before Applicants' U.S. priority filing date, much less prior to Applicants' Japanese priority filing date. For at least this reason, Applicants respectfully submit that Cubic is not prior art and, therefore, cannot be used to establish a *prima facie* case of obviousness.

The Examiner indicated during the Interview that Applicants conceded that Cubic's teachings were prior art because Applicants cited the Cubic reference in an Information Disclosure Statement. Applicants respectfully disagree and submit that the Cubic reference was originally cited by the Examiner in the parent application. Applicants have cited the Cubic reference (along with other references that were cited by the Examiner and by Applicants in the parent application) in the present divisional application in order to meet their duty of candor before the Patent Office. Furthermore, Applicants respectfully submit that a mere listing of a reference in an Information Disclosure Statement cannot be taken as an admission that the reference is prior art against the claims. (*See* MPEP 2129 citing *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354-55, 66 USPQ2d 1331, 1337-38 (Fed Cir. 2003) (listing of applicant's own prior patent in an IDS does not make it available as prior art absent a statutory basis); *see also* 37 CFR 1.97(h) ("The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(b).").

Second, Applicants respectfully submit that Cubic fails to remedy the deficiencies of Aubrey. Specifically, Cubic fails to teach or suggest all the claimed features. Cubic is merely a collection of press releases that describes Cubic's worldwide business operations. Cubic is not, however, an enabled disclosure that teaches or suggests the specific features of claim 23. As an example, Cubic is completely silent about a third judging means for judging whether the second wireless ticket is the same as the first wireless ticket that is carried by the first user who was approved to pass by the approving means based on the using data received by the second receiving means. As another example, Cubic is silent about a prohibiting means for prohibiting the execution of judging the passing property of the second user by the second judging means when the second wireless ticket is judged to be the same as the first wireless ticket by the third judging means. Therefore, the combination of Aubrey and Cubic cannot result, in any way, in the invention of claim 23.

The Examiner indicated during the Interview that the Cubic reference inherently discloses the features of claim 23. Applicants respectfully disagree and point out that "in relying upon the theory of inherency, the examiner must provide a basis in fact and/or

technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art.” (See MPEP 2112 citing Ex Parte Levy, 17 U.S.P.Q. 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). All that is disclosed in Cubic are press releases that indicate the construction of smart card ticketing facilities. Cubic is, however, silent about any specific features of the smart card ticketing facilities, much less about the specific features disclosed in claim 23. Therefore, the features of claim 23 cannot flow from the teachings of Cubic. Therefore, Cubic cannot inherently disclose the features of claim 23.

Furthermore, Applicants respectfully submit that Cubic does not include an enabled disclosure that can be used to remedy the deficiencies of Aubrey. For at least this reason, Cubic cannot be used for the purpose of allegedly remedying the deficiencies of Aubrey.

Third, Applicants respectfully submit that there is no motivation or suggestion in Aubrey and/or Cubic to provide the system disclosed in claim 23. Applicants note that the invention of claim 23 cannot be rendered obvious in view of the teaching of Aubrey because Aubrey teaches away from the present invention. (See MPEP 2143).

Aubrey merely discloses a fare collection ticket transport mechanism that is configured to control traffic in a single direction. (See FIG. 1) Aubrey specifically discloses that the transport mechanism 10 may be associated with an entry or the exit gate of the system, or be provided at the entrance to a transit vehicle such as a bus. (See col. 6, lines 32-37 and col. 1, lines 25-32). Therefore, by virtue of specifically disclosing that the transport mechanism 10 is positioned either at an entry or an exit gate of a system, **Aubrey clearly teaches away from an apparatus capable of checking/controlling traffic in a first direction and in a second direction, opposite the first direction, at the same time, i.e., at an entry and at an exit of a system.** Therefore, for at least this reason, Applicants respectfully submit that claim 23 cannot be rendered obvious in view of Aubrey’s teachings.

The Examiner indicated in the Interview Summary that:

“the first/second/third judging means and prohibiting are just functional steps performed by a single processing means. For instance, when a user enters a transit system, the system processor judges the user based on information from the wireless card to either allow and prohibit the user from entering the system’s facility. At the exit station, the system performs a second and third judging steps to verify the card is valid and has enough value therein and that the same exit card is being exited.”

However, Applicants respectfully submit that the reasons set forth by the Examiner in the Interview Summary for maintaining the rejection of claim 23 are not commensurate in

scope with the claim language. In particular, claim 23 recites that the third judging means judge whether the second wireless ticket is the same as the first wireless ticket that is carried by the first user who was approved to pass by the approving means based on the using data received by the second receiving means, and that the prohibiting means prohibits the execution of judging the passing property of the second user by the second judging means when the second wireless ticket is judged to be the same as the first wireless ticket by the third judging means. These features are not the same as those indicated by the Examiner in the Interview Summary. Therefore, Applicants respectfully submit that the reasons set forth by the Examiner for maintaining the rejection of claim 23 are improper.

For at least the foregoing reasons, Applicants respectfully submit that claim 23 is patentable over Aubrey, Cubic and a combination thereof. Claims 24 and 25 are patentable over Aubrey, Cubic and a combination thereof at least by virtue of their dependency from claim 23 and for the additional features recited therein.

Claim 26 is patentable over Aubrey, Cubic or a combination thereof for similar reasons as provided in claim 23, and for the additional features recited therein. Namely, claim 26 is patentable over Aubrey, Cubic or a combination thereof at least because claim 26 recites an automatic ticket checking apparatus comprising, *inter alia*, a main body to define a prescribed passage which defines a first passage to one side thereof and a second passage to another side thereof; a third judging means for judging a passing propriety of the second user based on the result of the wireless communication with the second wireless ticket by the second wireless communication means when the second wireless ticket is not the same as the first wireless ticket by the second judging means; and a prohibiting means for prohibiting the judgment of the third judging means when the second wireless ticket is judged to be the same as the first wireless ticket by the second judging means. Applicants respectfully submit that these features are not rendered obvious in view of Aubrey and Cubic for at least similar reasons as provided in claim 23. Furthermore, Applicants respectfully submit that Cubic is not prior art. Therefore, claim 26 is patentable over Aubrey, Cubic and a combination thereof.

Claims 26-32 are patentable over Aubrey, Cubic and a combination thereof at least by virtue of their dependency from claim 26.

Claim 33 is patentable over Aubrey, Cubic or a combination thereof for similar reasons as provided in claim 23, and for the additional features recited therein. Namely, claim 33 is patentable over Aubrey, Cubic or a combination thereof at least because claim 33 recites an automatic ticket checking apparatus comprising, *inter alia*, a main body which

defines a first passage to one side thereof and a second passage to another side thereof; a second judging means for judging whether the second wireless ticket with which wirelessly communicated is the same as the first wireless ticket stored in the storage means based on the wireless communication by the second wireless communication means; a prohibiting means for prohibiting a user to pass the second passage when the wireless ticket with which wirelessly communicated by the second wireless communicating means is judged to be the first wireless ticket by the second judging means; and a control means for prohibiting the storing of the storage means when the second wireless communicating means is not making the wireless communication with a wireless ticket. Applicants respectfully submit that these features are not rendered obvious in view of Aubrey and Cubic for at least similar reasons as provided in claim 23. Furthermore, Applicants respectfully submit that Cubic is not prior art. Therefore, claim 33 is patentable over Aubrey, Cubic and a combination thereof.

Claim 37 is patentable over Aubrey, Cubic or a combination thereof for similar reasons as provided in claim 23, and for the additional features recited therein. Namely, claim 37 is patentable over Aubrey, Cubic or a combination thereof at least because claim 37 recites a ticket checking method of an automatic checking apparatus including a main body which defines a first passage to one side thereof and a second passage to another side thereof, a first receiving means provided to the main body for receiving using data from a first wireless ticket which is carried by a first user who is passing the first passage in a first direction and recording the using data, first judging means for judging a passing property of the first user based on the using data received by the first receiving means, approving means for approving the passing of the first user when the passing is judged to be approved by the first judging means, second receiving means provided to the main body for receiving using data from a second wireless ticket which is carried by a second user passing the second passage in a second direction opposite to the first direction and recording the using data, second judging means for judging a passing property of the second user based on the using data received by the second receiving means, the method comprising: judging whether the second wireless ticket is the same as the first wireless ticket that is carried by the first user who has approved to pass by the approving means based on the using data received by the second receiving means; prohibiting the execution of judging the passing property of the second user by the second judging means when the second wireless ticket is judged to be the same as the first wireless ticket by the third judging means; and executing the judging a

passing property of the second user by the second judging means when the second wireless ticket is judged differing from the first wireless ticket by the third judging means.

Applicants respectfully submit that these features are not rendered obvious in view of Aubrey and Cubic for at least similar reasons as provided in claim 23. Furthermore, Applicants respectfully submit that Cubic is not prior art. Therefore, claim 37 is patentable over Aubrey, Cubic and a combination thereof.

Accordingly, reconsideration and withdrawal of the rejection of claims 23-33 and 37 under 35 U.S.C. §103(a) based on Aubrey in view of Cubic are respectfully requested.

In view of the foregoing, the claims are believed to be in form for allowance, and such action is hereby solicited. If any point remains in issue which the Examiner feels may be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

The rejection having been addressed, it is respectfully submitted that the present application is in condition for allowance and a Notice to that effect is earnestly solicited.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP



CHRISTOPHE F. LAIR

Reg. No. 54248

Tel. No. 703.905.2097

Fax No. 703.905.2500

JPD/CFL
P.O. Box 10500
McLean, VA 22102
(703) 905-2000